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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/222,336	12/28/1998	GUY A. STORY JR.	02541.P009	3308

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EXAMINER

RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/222,336

Applicant(s)

STORY ET AL

Examiner

Yehdega Retta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2005.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-18 and 20-36 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-8, 10-18, 20-36 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) ☐ Notice of Informal Patent Application (PTO-152)
 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

This office action is response to the Amendment filed May 27, 2005. Applicant amended claims 1, 3, 11, 13, 21, 23, 24 and added new claims 31-36. Claims 9 and 19 are cancelled.

Claims 1-8, 10-18, 20-36 are currently pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-8, 10-18, 20-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 11, 21, 31 recites "creating a first license comprising a first cardinality, wherein the cardinality indicates the number of playback devices that can be authorized for playback of associated digital audio content". Applicant's specification teaches creating a first license having an associated cardinality that determined the number of playback devices that can be authorized by the license. Also the specification teaches the license is comprised of 32 bit group ID, or other identifier size. Further the specification discloses that each playback device storing a license belongs to a set of one or more playback devices storing the license, and the set being authorized to play the content. The license does not comprise of cardinality according to

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applicant's disclosure. According to applicant's specification the license is associated with the cardinality by authorizing each device storing the identifier (license) to play content that include the same identifier (license). The number of devices that are authorized to play the content (cardinality) is associated with the license. Since the specification does not teach the "license comprising of cardinality", it is considered new matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8, 10-18, 20-30 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Katz et al. U.s. Patent No. 5,926,624.

Regarding claims 1-3, Katz teaches creating one or more licenses having cardinality associated with the license, the cardinality indicating the number of authorized playback devices (see col. 12 lines 39-67); transmitting the license, via network connection, to playback devices authorizing playback of the digital audio content with the playback devices (software or hardware) (see fig. 2, col. 11 line 32 to col. 12 lines 67); Katz teaches transmitting configuration data, which includes Group ID, storing the Group ID in the playback devices and authorizing only the playback devices defined by the Group ID (see col. 8 lines 5-62, col. 9 line 13 to col. 10 line 67 and col. 11 line 31 to col. 12 line 66); storing the license in digital audio contents, and

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determining whether playback of digital audio content is authorized to by comparing the first license with the digital content having the licenses embedded (see col. 13 lines 19-58). Katz teaches that the server (260) creating a targeted header for selected files (the targeted header linked with the corresponding digital information), the header comprises a combination of the descrambling map with the private player IDs corresponding to the targeted playback devices etc. (see col. 13 line 30 to col. 14 line 27), storing a first license in second digital audio content and authorizing playback of the second digital audio content with the first set of playback devices; creating a second license having a second cardinality ... (see col. 12 lines 55-64).

Regarding claims 4-6, 14-16 and 25-27, Katz teaches wherein the cardinality is fixed (see col. 11 lines 32-53); variable or unlimited (see col. 12 lines 39-67).

Regarding claims 7, 8, 17, 18, 28 and 29, Katz teaches playback devices comprising a hardware or software devices (see col. 11 lines 19-31 and col. 15 lines 30-62).

Regarding claims 10, 20 and 30, Katz teaches the digital content comprises of video digital programming (see col. 5 lines 45 to col. 6 line 3 and col. 18 line 66 to col. 19 line 4).

Claims 11-13 and 21-23 are rejected as stated above in claims 1-3 respectively.

Claim 24 is rejected as stated above in claim 1.

Regarding claims 31-33, Katz teaches receiving a first license (Group ID) at a playback device, the playback device belonging to a first set of playback devices; (player or group ID), the license comprising (having associated) a first cardinality, wherein a cardinality indicating a number of playback devices that can be authorized for playback of digital content, wherein the first set of playback devices is less than or equal to the first cardinality; storing the first license in the playback device; receiving first digital content, wherein information associated with the first

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license is embedded in the in the first digital content; and determining whether playback of the received first digital content by the playback device is authorized by comparing the first license stored in the playback device with the first license information embedded in the first digital content; (see col. 8 lines 5-62, col. 9 line 13 to col. 10 line 67 and col. 11 lines 32-53 and col. 12 lines 24-66).

Regarding claims 34-36, Katz teach creating a first license having a first cardinality associated with the license wherein a cardinality indicates the number of playback devices that can be authorized for playback of associated digital content; transmitting information corresponding to the first license to a content provider, a first digital content (audio) (see col. 5 lines 45-65) at the content provider to be embedded with the first license information; transmitting the first license to a first set of playback devices, wherein the first set of playback devices is less than or equal to the first cardinality, the first set of playback devices to render first digital content provider by the content provider based on a match between the first license and the first information embedded in the first digital content(see col. 8 lines 5-62, col. 9 line 13 to col. 10 line 67 and col. 11 lines 32-53 and col. 12 lines 24-66).

Response to Arguments

Applicant's arguments filed May 27, 2005 have been fully considered but they are not persuasive.

The prior art, Katz teaches a license management device (Server 260) generating a license (Group ID) and the license transmitted to playback devices (see fig. 2& 10, col. 8 lines 30-63 and col. 12 lines 39-67). Katz further teaches the library server 260 utilizes a set of identifiers (i.e. player ID) for mobile playback devices authorized to receive the selected

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download data from the library, the library formatting the downloads data that can only be read by mobile devices with these identifiers (see col. 11 lines 39-48). Katz also teaches playback devices logically grouped together using a Group ID and digital information content, software, or configuration data changes targeted to a group of mobile playback devices defined by a group ID. Each Player storing one or more group ID of which the particular player is a member, playback devices of the same group share the same Group ID (see col. 12 lines 39-66). Players with the same Group ID, indicates the number of playback devices that are authorized to playback the content (cardinality). Examiner would like to point out that according to applicant's specification, the license have a cardinality associated with it, which indicate the number of authorized playback devices. Also according to applicant's specification, see page 12, the **license is comprised of 32 bit group ID, or other identifier size**. Further the specification discloses that each playback device storing a license belongs to a set of one or more playback devices storing the license, and the set of playback devices are authorized to play the digital content, which is the same as the Katz system.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YR


RETTA YEHDEGA
PRIMARY EXAMINER